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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/291,983 04/15/99 MARTIN

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EXAMINER

QM12/0926

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DEXTER, C

ART UNIT

PAPER NUMBER

3724

DATE MAILED:

09/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/291,983

Applicant(s)
Martin et al.

Examiner
Clark F. Dexter

Art Unit
3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 11, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-23 is/are pending in the application.
- 4a) Of the above, claim(s) 10-15 and 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 16, and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

Request for Continued Examination

1. The Request for Continued Examination (RCE) under 37 CFR 1.114 filed on July 11, 2000 is acceptable and an RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-9, 16 and 23 are rejected under 35 U.S.C. 102(b) as anticipated by the hacksaw disclosed in the Appendix A catalog, Product ID No. 20-001 (hereafter Product '001) or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Appendix A Catalog, Product ID No. 20-001 (hereafter product '001) in view of David, pn 3,329,186.

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Initially, it is respectfully submitted that the catalog items submitted in Appendix A are assumed to be prior art with respect to the present invention. With that assumption, the following prior art rejection is applicable.

Product '001 discloses a hacksaw with every structural limitation of the claimed invention.

In the alternative, if it is argued that Product '001 does not include the claimed blade mounting structure including a first blade mounting structure and a releasable blade tensioning device, the Examiner takes Official notice that such structure is old and well known in the art for tensioning the blade (e.g., to compensate for stretching thereof) and for removing the blade (e.g., for replacement thereof). David teaches an example such structure in Figure 8. Therefore, it would have been obvious to one having ordinary skill in the art to provide such blade mounting structure on the hacksaw of Product 20-001 for the well known benefits including those described above.

Claim Rejections - 35 USC § 103

5. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the hacksaw disclosed in the Appendix A catalog, Product ID No. 20-001 (hereafter Product '001) or, in the alternative, under 35 U.S.C. 103(a) as unpatentable over the Appendix A Catalog, Product ID No. 20-001 (hereafter product '001) in view of David, pn 3,329,186.

Product '001 or the combination of Product '001 in view of David lacks the specific measurements various claimed radii. However, these specific measurements would be the mere

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discovery of the optimum or workable ranges within the general conditions of the prior art by routine experimentation and therefore obvious to one having ordinary skill in the art.

6. Claims 1, 3-9, 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over David, pn 3,329,186, in view of Wells, pn 679,653 (hereafter Wells '653).

David discloses a hacksaw with almost every structural limitation of the claimed invention but lacks the frame member having an arcuate portion extending substantially the entire length between the forward end portion and the maximum height portion. Wells '653 discloses a frame member with such an arcuate portion and teaches that the curved characteristic and the tubular characteristic combined provide a desired degree of elasticity along with the requisite strength to strain the saw blade for cutting. It is noted that the I-beam-shaped frame member of David is considered an equivalent strengthening characteristic of the frame member of David. Further, the Examiner takes Official notice that it is old and well known in the art, particularly the mechanical arts, that corners or sharp bends or the like create stress risers wherein stress is concentrated in a relatively small area of a component which may lead to premature failure of the component in that area. It is further known that to alleviate this problem, the material in that area must be either "overdesigned" (i.e., designed with stronger material or enough additional material to provide the needed extra strength and endurance for a sufficiently long life for the component) or designed more "efficiently" without such corners or curves to eliminate the stress concentration areas which usually provides benefits such as requiring less material resulting in a lighter weight component. Therefore, it would have been obvious to one having ordinary skill in the art to

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provide the frame member of David with the claimed arcuate portion for providing an efficient design along with the other well known benefits described above as well as those taught by Wells.

Further, the specifics of the arcuate portion as defined in the dependent claims, specifically the specific measurements of claims 6-9, would be the mere discovery of the optimum or workable ranges within the general conditions of the prior art by routine experimentation and therefore obvious to one having ordinary skill in the art.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 3-9, 16 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Patent No. Des. 403,224 to Martin et al. in view of Hepworth et al.

Martin et al. discloses a hacksaw frame and lacks an elongated blade attached to the frame by a first mounting structure and a second mounting structure in the form of a tensioning device.

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However, to provide a blade and mounting structure to mount the blade onto the frame is inherent in the invention of Martin et al. since it is a hacksaw frame which is intended to be used with such structure. Further, to provide a tensioning structure as one of the mounting structures is old and well known in the art as evidenced by Hepworth et al. for facilitating removal and assembly of the blade onto the saw frame. Therefore, it would have been obvious to one having ordinary skill in the art to provide an elongated blade attached to the frame by a first mounting structure and a second mounting structure in the form of a tensioning device to perform the intended use of the frame and for the well known benefits including that described above.

Response to Arguments

9. Applicant's arguments and the Declaration filed May 10, 2001 have been fully considered but they are not persuasive.

Prior Art

10. Applicant is requested to submit additional information (e.g., the name of the catalog and the publication date) regarding the catalog submitted as Appendix A in the response filed May 10, 2001 or state that the information disclosed in the catalog is not prior art.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', is positioned above the printed name.

Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
September 24, 2001

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.